To:	Hansen Beverage Company (efiling@kmob.com)
Subject:	TRADEMARK APPLICATION NO. 78529821 - JOKER MAD ENERGY - HANBEV.062T
Sent:	9/6/06 1:31:23 PM
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Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/529821

APPLICANT: Hansen Beverage Company

CORRESPONDENT ADDRESS:
STEVEN J. NATAUPSKY
KNOBBE, MARTENS, OLSON & BEAR LLP
2040 MAIN ST FL 14
IRVINE, CA 92614-7216

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: JOKER MAD ENERGY

CORRESPONDENT'S REFERENCE/DOCKET NO: HANBEV.062T

CORRESPONDENT EMAIL ADDRESS:
efiling@kmob.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 78/529821

Denial of Applicant's Request for Reconsideration

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the point(s) at issue in the final action. TMEP §715.03(a). Accordingly, applicant's request for reconsideration is denied and the refusal is continued. 37 C.F.R. §2.64(b); TMEP §715.04.

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

Reasons for Denying Applicant's Request for Reconsideration

Applicant's communication filed on January 19, 2006, included 1) a revised recitation of goods, 2) an argument against the requirement for a disclaimer of the word "ENERGY," and 3) an argument against

the Trademark Act Section 2(d) refusal to register.

The examining attorney carefully considered the applicant's arguments regarding the refusal pursuant to Section 2(d) of the Trademark Act and the requirement for the disclaimer, but found them unpersuasive. For the reasons set forth in the February 13, 2006 Final Office Action, the refusal under Trademark Act Section 2(d) and the requirement that the applicant disclaim the word "ENERGY" was maintained and made FINAL. 37 C.F.R. §2.64(a).

Applicant's communication filed on August 14, 2006, includes a proposed revision to the identification of goods to "Beverages, namely, carbonated and non-carbonated energy drinks, excluding fruit drinks and fruit juices" and a disclaimer of the word "ENERGY." Both items are acceptable and will be made part of the official record. The requirement for a disclaimer is hereby withdrawn. However, despite the amended identification of goods, the applicant has not submitted any new facts or argued any new reasons against the Trademark Act Section 2(d) refusal to register.

The examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark(s) in U.S. Registration No(s). 1248571, 1554967, and 2521457 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP §§1207.01 et seq. See the **previously enclosed** registrations.

Applicant's mark, "JOKER MAD ENERGY," shares the identical term "JOKER" that comprises the entire registered marks of U.S. Registration Nos. 1248571, 1554967, and 2521457 and is therefore confusingly similar to the registered marks. Further, the parties' goods remain related, if not identical, despite the applicant's amendment to exclude "fruit drinks and fruit juices."

Applicant's newest amended identification of goods is "Beverages, namely, carbonated and non-carbonated energy drinks, excluding fruit drinks and fruit juices." The registrant's goods are:

> In U.S. Registration No. 2521457 - "beers, mineral and aerated waters, and soft drinks; fruit drinks and fruit juices, nectar, juices with pulp, fruit concentrate, fruit juices based on concentrate and powders for making beverages" and "alcoholic beverages, namely, wines, hard cider, liqueurs, cordials, brandies, cognac, scotch whiskey, rum, gin and vodka";
>
> In U.S. Registration No. 1554967 - "FRUIT DRINKS AND FRUIT JUICES"; and
>
> In U.S. Registration No. 1248571 - "FRUIT JUICES."

Although the applicant does not present any arguments at all in its latest response, presumably applicant believed that excluding "fruit drinks and fruit juices" would obviate the likelihood of confusion between the marks. However, as the examining attorney previously stated, the parties' goods in this case are related because they include **beverages that would be found in the same channels of trade and sold in the same stores, i.e. grocery stores in the beverages aisles**. In other words, the registrations all identify goods like soft drinks and juices that are sold with and often right next to energy drinks and the like. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Corning Glass Works, 229 USPQ 65 (TTAB 1985);*

In re Rexel Inc., 223 USPQ 830 (TTAB 1984); Guardian Prods. Co., Inc. v. Scott Paper Co., 200 USPQ 738 (TTAB 1978); In re Int'l Tel. & Tel. Corp., 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Additionally, any goods or services in the registrant's normal fields of expansion must also be considered in order to determine whether the registrant's goods or services are related to the applicant's identified goods or services for purposes of analysis under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). The test is whether purchasers would believe the product or service is within the registrant's logical zone of expansion. *CPG Prods. Corp. v. Perceptual Play, Inc.*, 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v). Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods listed therein, **namely fruit juices, soft drinks, and energy drinks**, are of a kind that may emanate from a single source. See *In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

As a result, the applicant's exclusion of "fruit drinks and fruit juices" does not overcome the likelihood of confusion between applicant's mark "JOKER MAD ENERGY" on "Beverages, namely, carbonated and non-carbonated energy drinks" and the registrant's "JOKER" mark on "soft drinks" and other beverages. See previously attached evidence demonstrating that the third-party registrations of marks used in connection with the same or similar goods as those of applicant and registrant in this case, namely fruit juices, soft drinks, and energy drinks, are of a kind that may emanate from a single source.

A consumer encountering the mark "JOKER MAD ENERGY" on a carbonated energy drink would incorrectly believe that it originated from the same source as the "JOKER" soft drink or fruit drink or fruit juice. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. Therefore, registration is refused under Trademark Act Section 2(d) and the request for reconsideration is denied.

/Tasneem Hussain/
Trademark Examining Attorney
Law Office 105
(571) 272-8273